

**REMARKS**

Upon entry of this paper, claims 1 and 5 have been amended, claim 2 has been canceled, and no claims have been added as new claims. Thus, claims 1, and 3-5 are presently pending in this application. No new matter has been added.

**Specification Recommendations**

Applicant thanks the Examiner for the detailed summary of the guidelines for the preferred layout and content for patent applications. However, Applicant believes that the Preliminary Amendment filed January 2, 2002, and the Response filed March 18, 2004 have adequately addressed the format of the application, and have followed the recommended guidelines. Accordingly, Applicant provides no additional amendments to the Specification at this time, other than the paragraph relating the priority information as confirmed by the Official Filing Receipt. Should the Examiner wish to have any further amendments made to the Specification, the Examiner is hereby invited to specifically detail such changes.

Applicant has added Related Applications information to the beginning of the Specification to properly refer to the priority acknowledged in the filing receipt of the pending Application.

**Claim Rejections under 35 U.S.C. §112**

Claims 1-5 were rejected under 35 U.S.C. §112, paragraph 1, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. Applicant has amended claims 1, and 5, and canceled claim 2, and have additionally amended the specification per the Examiner's suggestion. Applicant further provides the following remarks in support of allowance of the pending application.

The Examiner has maintained the position that "a person having average skill in the art cannot clearly see and/or understand that the claimed hearing aid, especially showing in Figs. 1-

6, can be used as a BTE type hearing aid as claimed.” *See* Advisory Action, paragraph 2. The Examiner has further requested amendment to the drawings and specification.

Applicant has amended the description of the drawings to more clearly indicate that which has been illustrated in the figures as filed. The amended description clearly indicates that the device shown in Figs. 1-3 is a behind the ear (BTE) hearing aid device. Other than providing this description, Applicant is aware of no means by which the figures could be amended to further indicate that the device shown is a BTE hearing aid device. The Examiner has stated that a “BTE type hearing aid usually refers to a hearing aid having a long, thin and curvature, or ‘hook’ shaped configuration.” *See* Advisory Action, paragraph 2. The device shown in Figs. 1-3 matches the Examiner’s description of what is commonly identified as a shape for a BTE hearing aid. As such, the Examiner’s own words confirm that Figs. 1-3 adequately depict a BTE hearing aid, as described.

Fig. 4 has been previously amended to indicate that the device illustrated is a “Prior Art” front plate or faceplate. The description of Fig. 4 of a device “designed for use with in ear hearing aids”, in addition to description provided in the specification on pages 1 and 3, further support the characterization of the device of Fig. 4 as being a multifunction plate designed for use in an in-ear hearing aid device. Applicant is aware of no other way to depict this conventional device known by those of ordinary skill in the art.

The brief description of Figs. 5 and 6 has been amended to clarify that the figures depict “a behind the hear hearing aid coupled with the face plate for use with in ear hearing aids of Fig. 4, according to the present invention”. Again, Applicant is aware of no other way to depict the combination of the multifunction faceplate with the BTE housing to form a BTE hearing aid device in accordance with the present invention.

If the Examiner is still of the opinion that it is not clear that Figs. 5 and 6 are depicting a BTE hearing aid device as claimed, Applicant hereby request a telephone interview with the Examiner to resolve such misunderstanding. Applicant’s below signed representative can be reached at 617-227-7400.

Applicant reminds the Examiner that according to MPEP Manual of Patent Examining Procedures § 2163, “[p]ossession may be shown in a variety of ways including . . . showing that the invention was "ready for patenting" such as by the disclosure of drawings . . . that show that the invention was complete . . .” See, e.g., Pfaff v. Wells Electronics, Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); Eli Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406; Amgen, Inc. v. Chugai Pharmaceutical, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991)

Furthermore, “[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”).”

Applicant respectfully submits that the Examiner has not met the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. Specifically, the Examiner merely states that “it is not clear how to alter a conventional/commercially available faceplate, usually used in an ITE or CIC hearing aid and in rather small size, to provide a side plate of a BTE hearing aid.” See OA, paragraph 3. The Examiner has further provided that “a person having average skill in the art cannot clearly see and/or understand that the claimed hearing aid, especially showing in Figs. 1-6, can be used as a BTE type hearing aid as claimed.” See Advisory Action, paragraph 2

Applicant respectfully submits that which the Examiner claims is not clear is specifically described and depicted in the Specification and Figures as provided above and further elaborated upon below. The Specification states with regard to this element of the invention that, “This front plate may easily be mounted on top of the housing shell of the BTE device to be produced, the technical components being accommodated by the housing shell. Any remaining overhanging edges of the front plate, which is usually made of plastic and easily worked, are ground off.” See Specification, page 2, lines 5-8. The Specification further states that, “[t]he manufacturer of the front plates simply modifies the injection mold for the plastic so as to match

the contour of the front plate to the contour of the housing shell. Insertion of devices into the front plate so modified may thus be accomplished by the manufacturer in precisely the same ways as with previous conventional front plates.” See Specification, page 2, lines 13-16. In addition, the Specification states that, “the front plate may be initially fabricated with the larger dimensions, fitted with the electronic components, and subsequently adapted in a cost-effective manner to the contour of the housing shell of a BTE device, for example, by using an automated punch or milling procedure. Excess material may then be removed before the front plate and housing shell are joined while retaining optimal accessibility of the front plate and without risking damage to the housing shell.” See Specification, page 2, lines 22-28.

The Figures 5 and 6 specifically show the combination of the conventional ITE faceplate 4 coupled with the BTE housing shell 1, which is significantly larger than the prior art ITE housing shell (as known by those of ordinary skill in the art). The faceplate 4 is the same size for both the BTE application and the ITE application. This is illustrated by the relative difference between the size of the BTE housing shell 1 relative to the standardized faceplate 4 in Figure 5, and the size of the ITE housing shell 2 relative to the standardized faceplate 2 in US Patent No. 6,430,296. The present invention makes use of the standardized faceplate for use with the ITE, but rather than using the faceplate for the ITE, the present invention couples the same standardized faceplate with the BTE, which is clearly illustrated.

Applicant further provides the following one-to-one comparison between claim 1, and the Description and Figures.

Claim 1: A behind the ear hearing aid (Figs. 1-3), comprising a housing having a housing shell configured in a contoured shape (Figs. 1-3), an electronic circuit, a power storage unit, and a multi-function plate designed as a front plate (Fig. 4 and page 3, lines 22-30) and adapted to couple to the housing shell to form the behind the ear hearing aid by being shaped to match the contoured shape (Figs. 5 and 6), wherein the multifunction plate includes an access opening (Fig. 4) for one of the power storage unit and the electronic circuit.

Each of the above-described methods for forming the face plate to match the contours of the BTE shell make use of manufacturing methods that are known to those of ordinary skill in the art. In addition, each of the above-described figures clearly shows the coupling of the

standardized faceplate with the BTE hearing aid housing in accordance with the present claimed invention. Accordingly, Applicant has adequately described the invention to the extent necessary to support the claims under 35 U.S.C. §112.

Applicant respectfully requests reconsideration and withdrawal of all 35 U.S.C. §112 rejections.

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### CONCLUSION

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Applicant courteously solicits allowance of the claims in the form of a Notice of Allowance. Should there be any further outstanding issues of patentability following the entry of this amendment, a telephone interview is respectfully requested to resolve such issues.

Please charge any shortage or credit any overpayment of fees to our Deposit Account No. 12-0080. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized to be charged to the aforementioned Deposit Account. A duplicate copy of this sheet is enclosed.

Dated: December 8, 2004

Respectfully submitted,

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